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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,950	05/30/2006	Stephan Schlitter	291263US0PCT	8929
22850	7590	05/01/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
NGUYEN, CAM N				
ART UNIT		PAPER NUMBER		
1793				
NOTIFICATION DATE		DELIVERY MODE		
05/01/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/580,950

**Applicant(s)**

SCHLITTER ET AL.

**Examiner**

Cam N. Nguyen

**Art Unit**

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/11/07 (an election).  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4, 5 and 7 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 4, 5 and 7 is/are rejected.  
7) ☒ Claim(s) 6 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on originally filed is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-889)  
Paper No(s)/Mail Date 05/30/06  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### Response to Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1 & 4-7, in the reply filed on 10/11/07 is acknowledged. The traversal is on the ground(s) that “no adequate reasons and/or examples have been provided to support a conclusion of patentable distinctiveness between the identified groups. Also, it has not been shown that a burden exists in searching the claims of the three groups, etc.” This is not found persuasive because of the reasons provided in the restriction requirements. Further, the search required for Group I is not required for Group II or Group III, thus, if all groups are searched, an additional burden is imposed on the office due to different search areas being required. The Group II invention requires specific process steps and technique on how to prepare the catalyst, which the Group I invention does not require. The Group I invention requires the product components and composition including its characteristics, etc. In any event, in accord with the MPEP rule, if the elected product claims are found allowable, the process of use claims containing the allowable product limitations will then be rejoined. For purpose of search and examination on the merits, the restriction must be maintained.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 8-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention(s), there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/11/07.

3. Please note that claims 2-3 were originally canceled by applicants. However, they were inadvertently included as claims of the Group I invention in the restriction requirement. The corrected Group I invention should have been claims 1 & 4-7.

Claims 1 & 4-11 are currently pending in this application and under consideration.

#### **Claim Objections**

4. Claim 1 is objected to because of the following informalities:

In line 5, -- , -- must be inserted before "and".

Appropriate correction is required.

#### **Claim Rejections - 35 USC § 102(b)**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4-5, & 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Zhao et al., "hereinafter referred to as EP '658", (EP 1 000 658 A2).

EP '658 discloses a catalyst, which comprises copper oxide in an amount of 30-70 wt.%, zinc oxide in an amount of 30-70 wt.%, alumina in an amount of 0-30 wt.% and no sodium, the catalyst having a pore volume of 0.10-0.25 ml/g, and an average pore diameter of 10-25 nm and has an uniform crystallite distribution, etc. (see abstract and page 8, claims 1-13).

The disclosed copper oxide amounts, pore size distribution, and oxidic support amounts appear to be falling within the claimed ranges. Thus, the claims are anticipated by the teaching of the reference.

#### **Allowable Subject Matter**

7. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### **Citations**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All references are cited for related art. See PTO-892 Form prepared.

#### **Conclusion**

9. Claims 1 & 4-11 are pending. Claims 1, 4-5, & 7 are rejected. Claim 6 is objected. Claims 8-11 are withdrawn due to nonelected (distinct) invention. No claims are allowed.

#### **Contacts**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M-F, 9:00 AM - 6:30 PM, at alternative work site.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cam N. Nguyen/

Nguyen/cnn

Primary Examiner

December 24, 2007

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